

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Pieter VAN DALEN

Examiner: Yves Dalencourt

Serial No.: 10/070,497

Group Art Unit: 2157

Filed: JULY 19, 2002

Confirmation No.: 7026

For: METHOD FOR E-MAIL COMMUNICATION, APPARATUS THEREFOR AND
USE OF SAID METHOD AND APPARATUS FOR ELECTRONIC METERING AND FOR
HOME AUTOMATION

NEW BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

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Sir:

This New Brief on Appeal is submitted in Reply to the Notice of Non-Compliant Appeal Brief mailed December 19, 2008. Although it was believed the original description was sufficient, this New Brief adds further details to the concise explanation of the claimed subject matter, particularly references to the drawings.

This is an appeal from the decision of the Examiner finally rejecting claims 1-3, 9-12, 14-18 and 20-24 of the above-identified application.

(1) REAL PARTY IN INTEREST

The application is assigned of record to Van Dalen Management B.V., who is the real party in interest herein.

(2) RELATED APPEALS AND INTERFERENCES

Appellants, their legal representative and the assignee are not aware of any related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

(3) STATUS OF THE CLAIMS

Claims rejected: Claims 1-3, 9-12, 14-18 and 20-24.

Claims allowed: (none)

Claims canceled: Claims 4-8, 13 and 19.

Claims withdrawn: (none)

Claims on Appeal: Claims 1-3, 9-12, 14-18 and 20-24 (Copy of claims on appeal in attached Appendix).

(4) STATUS OF AMENDMENTS

No amendments after the Final Rejection have been proposed by Appellants.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' invention (independent claim 1) is directed to a method comprising: establishing e-mail communication between a sender device and a receiver device which both have access to the Public Switched Telephone Network, without the need of being connected to the Internet (see, e.g., page 1, lines 5-12; page 5, lines 1-9; original claim 1 of the specification; Fig. 1A elements 101, 102, 104, 106, 114 and 115; and Figs. 1G and 1H in their entirety). The method includes the steps of: A) establishing a data link, and point-to-point (PPP) connection between the sender and receiver devices (see, e.g., page 5, lines 14-19; original claim 1 of the specification; page 13, lines 14-29; and Figs. 1G and 1H); and B) transferring one or more e-mail message(s) from the sender device to the receiver device over TCP/IP (see, e.g., page 5, lines 20-24; original claim 1 of the specification; page 13, lines 14-29; and Figs. 1G and 1H). The dependent claims on appeal are also supported in appellants' specification, see, e.g., original claims 3, 9-12 and 14-18, and original claims 6-8, 11-12 and 16-17 supporting the apparatus claims. Regarding the separately argued aspects, for claims 3 and 22, see, e.g., page 5, lines 14-19; page 10, lines 26-31; page 11, lines 3-4; and Fig. 1A element 106. Regarding the separately argued aspects, for claims 9-12 and 23-24, see, e.g.:

page 7, lines 21-30; and Figs. 1D and 1F; Fig. 2A, element 105; and Fig. 2D. Regarding the separately argued aspects, for claims 14-18, see, e.g., page 8, lines 12-29; and Figs. 3A to 3D.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following sole ground of rejection is requested to be reviewed on appeal.

Separate consideration of certain claims subject to the rejection is indicated below.

1. The rejection of claims 1-3, 9-12, 14-18 and 20-24, on appeal, under 35 U.S.C. §103, for allegedly being obvious over Ho (U.S. Patent No. 5,805,298) in view of Tiller (U.S. Patent No. 5,568,563).
 - a. Claims 1-2 and 20-21, on appeal, are grouped together.
 - b. Claims 3 and 22, on appeal, are separately grouped together for the reasons given in the argument.
 - c. Claims 9-12 and 23-24, on appeal, are separately grouped together for the reasons given in the argument.
 - d. Claims 14-18, on appeal, are separately grouped together for the reasons given in the argument.

(7) ARGUMENT

1a. The Final rejection of claims 1-2 and 20-21 under 35 U.S.C. §103, as being obvious over Ho (U.S. Patent No. 5,805,298) in view of Tiller (U.S. Patent No. 5,568,563), is not supported on the record.

Ho in Figure 1 discloses components that could be considered to be a sender application [box 100] comprising a processing means attached to a modem connected via the PSTN [box 106] to a second modem attached to a second processing means [boxes 107 to 112]. The Ho apparatus requires routing of e-mail communications via the Internet [box 112].

Ho fails to disclose a method for establishing e-mail communication and sending e-mail

through a PSTN "without the need of being connected to the Internet." Compare the quoted recitation in claim 1; see also page 1, lines 9-11, of appellants' specification. Ho fails to disclose or suggest a method or system whereby a sender can send email to a receiver directly without any other recipient exclusively along a PSTN without routing via the Internet. By contrast, Ho requires the Internet [box 112] to perform email communication between two devices or users [box 100, box 104, box 105]; see, e.g., Fig. 1. See also, col. 3, lines 43-47 and 61-63, of Ho stating that a "Router typically transmits and receives electronic mail messages" and that "Remote Mail Servers, seen at 110-111, each implement electronic mail boxes of the type seen at 104-105 to receive electronic mail messages." In describing the functioning of the device, Ho states that upon identifying an email address "the communications device establishes a SLIP/PPP connection with the Router 107." As shown in Fig. 1, the Router and Remote Mail Servers are entities connected to the Internet. Figure 3 of Ho further shows that an email [box 304] is sent via the Internet [box 312]. The Final Office action mailed January 25, 2008 (page 4, fourth paragraph) acknowledges that Ho fails to teach performing its connection without need of the internet.

Appellants, thus, urge that Ho fails to teach a method for establishing e-mail communication without the need of being connected to the Internet. Ho only discloses that facsimiles – not email – can be sent directly through the PSTN. It is quite clear that Ho requires the use of the Internet to transmit e-mail messages between devices. Thus, Ho neither discloses nor suggests the method of the present invention, where the message is not sent over the internet, but is sent point-to-point through the PSTN.

Ho also gives no suggestion of modifying its methods/system to provide email communication exclusively between two users or devices using the PSTN without need of the Internet. As known by one of ordinary skill in the art, transmission via the Internet is inherently insecure because data is not routed directly between the sender and the recipient. It

is known that data sent through the Internet can be intercepted and recorded by servers in countries which do not maintain relevant privacy laws. The present invention offers a secure method of sending email, the advantages of which could not have been expected in view of Ho. Other advantages of the claimed invention are discussed, for example, at page 6, line 18, to page 7, line 9, and elsewhere in the disclosure. There is no incentive to arrive at the present invention from Ho or reason apparent from the record to modify the Ho method to arrive at appellants' invention. Ho fails to give any hint to direct PSTN emailing and no solution to the problem of providing transmission of data between two parties without need of the internet. Ho specifically requires use of the Internet for its method and there would need to be a strong suggestion to modify Ho to eliminate Internet use for its method since such a modification would be directly contrary to Ho's teachings.

Tiller was cited and alleged to disclose the idea of providing e-mail communication over the PSTN without the need of being connected to the Internet; citing Abstract and col. 7, lines 20-25. Although Tiller does not actually mention use of the internet, there is no suggestion from the reference that there is a direct PPP connection through the PSTN between sender and receiver. Tiller is directed merely to the receiver device in the system, particularly a personal communications device (apparently of the type now exemplified by a Blackberry). Tiller is directed to an "option attach connector" for such device. This "option attach connector" is used to determine whether incoming signals are from telephone, fax or email (modem). See, e.g., col. 3, line 40, to col. 4, line 2. Tiller discloses nothing regarding a sender device. Thus, Tiller, like Ho, provides no disclosure or suggestion of "establishing e-mail communication between a sender device and a receiver device which both have access to the Public Switched Telephone Network, without the need of being connected to the Internet" or "establishing a data link, and point-to-point (PPP) connection between the sender and receiver devices." Since Tiller does not indicate how the signal – when it is an email signal –

that is received at the "option attach connector" is sent, the only reasonable interpretation is that the e-mail was sent via the internet. In the absence of an indication otherwise, one of ordinary skill in the art could only assume that the term e-mail refers to e-mails sent via the internet, unless there is some indication to the contrary. The drawings, e.g., Figs. 5, and disclosure of Tiller only discuss the receiver device. There is no discussion of the sender device. Since the standard for e-mail is via the internet, the only reasonable interpretation when Tiller refers to e-mail is that it is e-mail sent through the internet.

Accordingly, appellants urge that Tiller fails to address the established deficiencies of Ho to teach or suggest the claimed invention. Tiller, like Ho, provides no suggestion of a method/system for email communication between sender and receiver devices using the PSTN without need of the Internet.

The combined teachings of Ho and Tiller provide no suggestion of modifying the methods/systems taught therein so as to provide email communication exclusively between two users or devices using the PSTN without need of the Internet. As discussed above, transmission via the internet is inherently insecure because data is not routed directly between the sender and the recipient. There is no incentive provided by the references or any other reasons of record for one of ordinary skill in the art to arrive at the present invention or achieve the advantages thereof in view of Ho and Tiller. The references give no hint to direct PSTN emailing and no solution to the problem of providing secure transmission of data between two parties.

In the "Response to Arguments" part of the Final action, the Examiner disagrees with appellants' argument that there is no suggestion from the references (either Ho or Tiller) that there is a direct PPP connection through the PSTN between sender and receiver. However, as established, Ho expressly requires use of the internet and, thus, it clearly cannot suggest a direct PPP connection through the PSTN between sender and receiver without need of the

internet. As for Tiller, appellants urge that there is no reasonable basis to conclude that Tiller does not use the internet as the source for the email received in its method. One of ordinary skill in the art could only assume that the term "e-mail" in Tiller refers to e-mails sent via the internet. Unless there is some indication to the contrary, one of ordinary skill in the art would conclude and could only conclude that an "e-mail" means an e-mail sent via the internet. Further, Tiller discusses nothing regarding a sending function. Thus, it suggests nothing regarding sending e-mail through a PSTN "without the need of being connected to the Internet."

It was further stated by the Examiner in the Final action that appellants argued there is no suggestion to modify/combine the references. However, appellants never made such an argument. Appellants' position was, and remains, that neither reference teaches a method for establishing e-mail communication and sending e-mail through a PSTN "without the need of being connected to the Internet." Since neither reference teaches such element of the claimed invention, even when the references are combined, they cannot teach such element. Further, there is no explanation or reason provided on the record to support that such a modification of the reference teachings would have been motivated merely by common sense or otherwise implicitly.

It was further alleged in the Final action (page 3) that "Appellants are interpreting the claims very narrow without considering the broad teaching of the reference used in the rejection." But no explanation was provided as to what aspect of the claimed invention appellants are interpreting too narrowly or what part of the reference appellants are not interpreting broadly enough. Appellants submit that they are not interpreting the claimed invention too narrowly. The claims unequivocally require establishing e-mail communication and sending e-mail through a PSTN without the need of being connected to the Internet. The claims do not need to be interpreted any more narrowly than this because even the broadest

teachings of the references do not suggest such a method.

For all of the above reasons, it is urged that the combined teachings of the Ho and Tiller references fail to provide a supportable basis for an obviousness rejection of claims 1-2 and 20-21 on appeal.

1b. The Final rejection of claims 3 and 22 under 35 U.S.C. §103, as being obvious over Ho (U.S. Patent No. 5,805,298) in view of Tiller (U.S. Patent No. 5,568,563), is not supported on the record.

The reasons provided above regarding Issue 1a. apply equally in supporting reversal of the rejection of claims 3 and 22, on appeal. Those reasons are incorporated herein by reference. However, the following further reasons apply for reversal of the rejection of claims 3 and 22 on appeal. The combined teachings of Ho and Tiller fail to teach or suggest a method further comprising the step of retrieving the telephone number of the receiver device from a database. The Final office action points to col. 6, lines 58-60, and col. 7, lines 6-17, as supporting such a step. However, the disclosure of Ho here merely relates to identifying an incoming signal as being a telephone number and, as a result, processing it for a fax transmission. There is no suggestion of retrieving a number from a database. This teaching in Ho further points out the distinction of appellants' invention as a whole. Ho teaches that, when the incoming signal is identified to be a telephone number, it is processed as a fax not an email. Thus, Ho further makes clear that it provides no teaching regarding sending and receiving emails via a telephone network.

For all of the above reasons, it is urged that the combined teachings of the Ho and Tiller references fail to provide a supportable basis for an obviousness rejection of claims 3 and 22 on appeal.

1c. The Final rejection of claims 9-12 and 23-24 under 35 U.S.C. §103, as being obvious over Ho (U.S. Patent No. 5,805,298) in view of Tiller (U.S. Patent No. 5,568,563), is not supported on the record.

The reasons provided above regarding Issue 1a. apply equally in supporting reversal of the rejection of claims 9-12 and 23-24, on appeal. Those reasons are incorporated herein by reference. However, the following further reasons apply for reversal of the rejection of claims 9-12 and 23-24 on appeal. The combined teachings of Ho and Tiller fail to teach or suggest a method further comprising establishing communication from a central host device to sender and receiver devices at remote locations, all with access to the Public Switched Telephone Network (PSTN), without the need of being connected to the Internet. Ho and Tiller teach nothing regarding use of a central host device for establishing the sender/received connection without use of the internet. The Final office action fails to address the central host device aspect of the invention in any way.

For all of the above reasons, it is urged that the combined teachings of the Ho and Tiller references fail to provide a supportable basis for an obviousness rejection of claims 9-12 and 23-24 on appeal.

1d. The Final rejection of claims 14-18 under 35 U.S.C. §103, as being obvious over Ho (U.S. Patent No. 5,805,298) in view of Tiller (U.S. Patent No. 5,568,563), is not supported on the record.

The reasons provided above regarding Issue 1a. apply equally in supporting reversal of the rejection of claims 14-18, on appeal. Those reasons are incorporated herein by reference. However, the following further reasons apply for reversal of the rejection of claims 14-18 on appeal. The combined teachings of Ho and Tiller fail to teach or suggest a method further comprising use of a TeleMail device to transfer an instruction to an addressed appliance

through the System Control Unit, and the main network, to an Appliance Control Unit. Ho and Tiller teach nothing regarding use of a TeleMail device or a method including providing instructions to an appliance control unit. The Final office action fails to address these aspects of the invention in any way.

For all of the above reasons, it is urged that the combined teachings of the Ho and Tiller references fail to provide a supportable basis for an obviousness rejection of claims 14-18 on appeal.

For all of the above reasons, it is urged that the decision of the Examiner rejecting claims 1-3, 9-12, 14-18 and 20-24, on appeal, is in error and should be reversed.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method comprising:

establishing e-mail communication between a sender device and a receiver device which both have access to the Public Switched Telephone Network, without the need of being connected to the Internet, further comprising the steps of:

A) establishing a data link, and point-to-point (PPP) connection between the sender and receiver devices; and

B) transferring one or more e-mail message(s) from the sender device to the receiver device over TCP/IP.

2. A method according to claim 1, further comprising the steps of:

C) composing one or more electronic mail messages on the sender device through a graphical user interface (GUI) application;

D) setting up a telephone connection and data link from the sender device to the receiver device;

E) accepting an electronic mail message from the sender device by the receiver device;

F) storing an electronic mail message on the receiver device;

G) terminating the data link and telephone connection;

H) perceptibly indicating that an electronic mail message has been received by the receiver device; and

I) visually presenting the electronic mail message, including attached files, by a graphical user interface (GUI) application on the receiver device.

3. A method according to claim 1, further comprising the step of:

J) retrieving the telephone number of the receiver device from a database.

9. Method of establishing e-mail communication according to claim 1, further comprising establishing communication from a central host device to sender and receiver devices at remote locations, all with access to the Public Switched Telephone Network (PSTN), without the need of being connected to the Internet, and allowing the collection of information from meters, including the steps of:

- a) setting up a telephone connection from the central host device to the sender and receiver devices at the remote locations;
- b) accepting a call by the receiver device;
- c) establishing a data link, and point-to-point (PPP) connection between the sender and receiver devices;
- d) transferring information to the host device over TCP/IP;
- e) terminating the data link and telephone call;
- f) updating of the database by the host device with the received information.

10. Method of establishing e-mail communication according to claim 1, further comprising establishing communication among a central host device and sender and receiver devices at remote locations, all with access to the Public Switched Telephone NetWork (PSTN), without the need of being connected to the Internet, and allowing the transfer of information from meters to the central host device, including the steps of:

- a) setting up a telephone connection to the central host device by the device at the remote location;
- b) accepting a call by the host device;
- c) establishing a data link, and point-to-point (PPP) connection between the sender and receiver devices;
- d) transferring information to the host device over TCP/IP;
- e) terminating the data link and telephone call;
- f) updating of the database by the host device with the received information.

11. Stand-alone apparatus which is able to perform all the applicable steps presented in claim 9, both as receiver and sender device, at the remote locations.

12. Host apparatus which is able to perform all the applicable steps of the central host device presented in claim 9, at the site of central host device.

14. Method of providing automated network functionality of an in-house main network as a TeleMail-based application, comprising the steps of:

- a) connecting a System Control Unit to a TeleMail device, and to the in-house

main network, which TeleMail device is capable of performing the steps of the receiver device in claim 1;

b) inserting Appliance Control Units between controlled appliances, and to the in-house main network;

c) installing and configuring a TeleControl application which provides a Graphical User Interface (GUI) program on the TeleMail device;

d) invoking the TeleControl Graphical User Interface (GUI) program;

e) activating controls in the Graphical User Interface (GUI), which are directly related to an addressable appliance;

f) invoking a Common Gateway Interface (GCI) process on the TeleMail device, to transfer an instruction to the addressed appliance through the System Control Unit, and the main network, to the Appliance Control Unit;

g) receiving and evaluating instructions by the Appliance Control Unit, which instructions are sent as one or more e-mail message(s) by a sender to the TeleMail device, as receiver, using a method of claim 1;

h) executing of the instructions by the Appliance Control Unit;

i) closing of the TeleControl Graphical User Interface program.

15. Method according to claim 14 further comprising automating the control over the controlled appliances at a receiver device location addressed by a TeleControl application, and connected to an in-house main network by means of a Scheduler as an integrated function of a Graphical User Interface (GUI) application, comprising the steps of:

a) invoking the TeleControl Graphical User Interface program;

b) activating the Scheduler control in the TeleControl Graphical User Interface program;

c) invoking and presenting the Scheduler Graphical User Interface;

d) configuring the Scheduler;

e) scheduling of actions at user-definable moments, and at user-definable fixed or irregular intervals;

f) closing of the Scheduler Graphical User Interface;

g) closing of the TeleControl Graphical User Interface program;

h) independently background executing the scheduled actions by the Scheduler

function.

16. Stand-alone or TeleMail-integrated System Control Unit to be connected to the TeleMail device, and to the main network, which is able to perform all the applicable steps presented in claim 14.

17. Stand-alone or appliance-integrated Appliance Control Unit to be connected to the addressed appliance, and to the main network, which is able to perform all the applicable steps presented in claim 14.

18. Method according to claim 14 wherein the System Control Unit identifier is unique, and the Appliance Control Unit has an assignable identifier in order to allow the method to uniquely qualify a home automation network, and the member Appliance Control Units connected to it.

20. An apparatus for performing the method of claim 1, which apparatus is connected to a computer through an interface and which is independently able to perform the steps, both as receiver and sender device, of:

A) establishing a data link, and point-to-point (PPP) connection between the sender and receiver devices;

B) transferring one or more e-mail message(s) from the sender device to the receiver device over TCP/IP;

D) setting up a telephone connection and data link from the sender device to the receiver device;

E) accepting a call by the receiver device;

F) storing of electronic mail message(s) on the receiver device; and

G) terminating the data link and telephone connection.

21. The apparatus of claim 20, wherein the interface is a RS-232 interface.

22. The apparatus of claim 20, which is further able to perform the steps of:

C) composing one or more electronic mail messages on the sender device through a graphical user interface (GUI) application;

I) visually presenting the electronic mail message, including attached files, by a graphical user interface (GUI) application on the receiver device; and
J) retrieving the telephone number of the receiver from a database.

23. Stand-alone apparatus to be installed at the remote location which is able to perform all the applicable steps presented in claim 10, both as receiver and sender device.

24. Host apparatus to be installed at the site of the central host device which is able to perform all the applicable steps presented in claim 9, both as receiver and sender device.

EVIDENCE APPENDIX

(None)

RELATED PROCEEDINGS APPENDIX

(None)